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10/693,195	10/24/2003	Randall R. Geib	0241-P03282US0	2326
110	7590	03/02/2006	EXAMINER	
DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/693,195

Applicant(s)

GEIB, RANDALL R.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005 and 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Restriction*

Applicant's election of invention I, claims 1-14 and 19-21 in the reply filed on 10/31/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicant has provided an additional amendment filed on 12/9/2005 to overcome the restriction requirement. After review, the examiner concludes the amendment still does not overcome the restriction because the device in the method is different than that claimed. In particular, the nut in the device is different than that in the method claims.

Claims 15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/31/2005.

### ***Drawings***

The drawings are objected to because the cross sectional view of the chamfered surface (unreferenced) of the flange 55 is not shown accurately. See attachment of marked-up Figure 2 to find the error in the cross sectional view. Applicant argues that the chamfers are correct; however, the examiner disagrees. Applicant should review the blown-up details in the attachment provided to see the difference between the error and what the drawing must show.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitations “a first connector” recited in claims 1, line 3, “a second connector” recited in claim 1, line 11, and “circumferential interlock” recited in claim 9, line 18 lack, proper antecedent basis in the specification.

Applicant has argued that the features are clearly illustrated and described in the application, and that the terms used in the claims and the terms used in the specification do not need to correspond. In response, applicant should note that the objection is not whether the drawings show these features or not, but whether the description provides antecedent basis according to MPEP 608.01(o). Applicant indicates that they are described in the specification but has failed to indicate where those features are described in the specification. Further, if applicant believes these features are described how come the specification, in particular, the detail description of the drawings, fail to mention a first connector, a second connector, and a circumferential interlock. According to the description, the drawings only show an inner sleeve, an outer sleeve and a locking nut. Therefore, there are no connectors in the figures.

Applicant is urged to review MPEP 608.01(o) as it states the use of a confusing variety of terms for the same thing should not be permitted. Claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901).

### ***Claim Objections***

Claims 1, 7, 9, and 11 are objected to because of the following informalities:

regarding claim 1, a comma is needed after "shaft" in line 2, "threads" in line 3 should be --a thread--, and "threads" in line 22 should be --thread-- as there is only one continuous thread and not multiple threads;

regarding claim 7, --axial-- needs to be inserted before "slots" in line 2 as these are the same axial slots recited in claim 1, line 9;

regarding claim 9, a comma is needed after "shaft" in line 2, "threads" in line 10 should be --a thread--, and "threads" in line 19 should be --thread--; and,

regarding claim 11, "outer sleeve" in line 1 should be --the external surface-- otherwise there would be two external surfaces one recited in claim 9, line 17 and the

other introduced in claim 11. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

***Claim Rejections - 35 USC § 112***

Claims 1-14, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "corresponding in diameter to the shaft" in line 20 makes reference to a component not being claimed, i.e., the shaft. Further, since shafts come in different shapes and sizes, it is unclear what particular shaft the claim tends to cover.

Regarding claim 9, the limitation "configured to engage the machine element" in line 11 makes unclear what configuration of the outer sleeve is required to allow the outer sleeve to engage the machine element. Further, the limitation "corresponding to the bore of the machine element" in line 17 makes reference to a component not claimed, i.e., the bore of the machine element.

Regarding claim 11, it is unclear whether "a frustoconical external surface" in lines 1-2 is the same external surface recited in claim 9, line 17, or another external surface.

Regarding claim 20, the claim sets to define the direction the inner sleeve moves relative to a component not claimed, i.e., the machine element. The claim needs to define the direction to the components of the device.

Regarding claims 2-8 and 19, the claims depend from claim 1 and therefore are indefinite.

Regarding claims 10-14, the claims depend from claim 9 and therefore are indefinite.

### ***Claim Rejections - 35 USC § 102***

Claims 9, 10, 13, 14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Muellenberg, 5,067,847 (see marked-up attachment provided in the last Office action).

Regarding claim 9, Muellenberg discloses, in Figures 3 and 11, a device, comprising a one-piece inner sleeve **10**, a nut **30**, and an outer sleeve **20**. The inner



sleeve **10** has a forward end **A15** and a rearward end **A31**. The inner sleeve **10** comprises a threaded portion **8**, a frustoconical external surface **6** and an internal bore **5**. The frustoconical external surface **6** has a major diameter **A35** adjacent the threaded portion **8** and a minor diameter **A14** spaced from the major diameter **A35** toward the forward end **A15** of the inner sleeve **10**. The nut **30** has a thread **15** at one end **A25** and a circumferential flange **17** at a distal end **A34**. The outer sleeve **20** has a forward end **A8** and a rearward end **A37**. The outer sleeve **20** comprises a frustoconical interior surface **12**, an exterior surface **12** and a circumferential interlock **13**. The frustoconical interior surface **12** correspond in angle of taper to the frustoconical external surface **6** of the inner sleeve **10**. The frustoconical interior surface **12** has a major diameter **A9** and a minor diameter **A7**. The major diameter **A9** is adjacent the rearward end **A31** and the minor diameter **A7** is adjacent the forward end **A8**. The exterior surface **12** corresponds to the bore **4** of the machine element **3**. The circumferential interlock **13** engages the flange **17** of the nut **30**.

Applicant should note that upon rotating the nut in a first direction, inherently, the threaded portion of the inner sleeve displaces the inner sleeve in one direction relative to the nut and the outer sleeve thereby displacing the major diameter of the inner sleeve external surface toward the minor diameter of the outer sleeve internal surface. Displacements cause the internal bore of the inner sleeve to contract against a shaft and the external surface of the outer sleeve to expand against a bore of a machine element.

Regarding claim 10, the flange **17** extends radially outwardly and the nut **30** further comprises an annular groove **16** adjacent the flange **17**. The outer sleeve **20** is a one-piece sleeve having sufficient resilience.

Regarding claim 13, the outer sleeve **20** comprises a stop **A29**.

Regarding claim 14, end **A45** of the inner sleeve **10** is continuous about the circumference.

Regarding claim 21, applicant should note that rotating the nut in a second direction inherently displaces the inner sleeve rearwardly relative to the nut, thereby loosening the inner sleeve from a shaft and the outer sleeve from a bore of a machine element.

***Claim Rejections - 35 USC § 103***

Claims 1-8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muellenberg, 5,067,847 (see marked-up attachment provided in the last Office action), in view of Geib, 6,361,243.

Regarding claim 1, Muellenberg discloses, in Figures 3 and 11, a device comprising a nut **30**, an outer sleeve **20**, and an inner sleeve **10**. The nut **30** has a thread **15** and a first connector **16**. The outer sleeve **20** comprises an external surface **12**, a tapered internal surface **11**, at least one axial slot **A10** (col. 4, lines 62-64) and a second connector **13**. The tapered internal surface **11** has a minor diameter **A7** adjacent a forward end **A8** of the outer sleeve **20** and a major diameter **A9** spaced rearwardly from the forward end **A8**. The axial slot **A10** extends longitudinally along the outer sleeve **20**. The second connector **13** is connected with the first connector **16**. The inner sleeve **10** comprises a tapered external surface **6** corresponding in angle of taper to the tapered internal surface **11** of the outer sleeve **20**. The inner sleeve **10** has a minor diameter **A14** adjacent a forward end **A15** of the inner sleeve **10** and a major diameter **A35** spaced rearwardly from the forward end **A15** of the inner sleeve **10**. The inner sleeve **10** has a threaded portion **8** remote from the forward end **A15** of the inner sleeve **10** and cooperates with the thread **15** of the nut **30**.

However, Muellenberg fails to disclose the external surface **12** being a tapered external surface **12**. Geib discloses an external surface of an outer sleeve **22** being tapered thus a tapered external surface to correspond to a bore of a machine element (col. 2, lines 36-39). Therefore, as taught by Geib, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the external surface **12** tapered thus a tapered external surface to correspond to a tapered bore of a machine element.

Applicant should note that rotating the nut in a first direction inherently displaces the inner sleeve forwardly relative to the nut, which displaces the major diameter of the external surface of the inner sleeve toward the minor diameter of the outer sleeve internal surface.

Regarding claim 2, the outer sleeve **20** comprises axial slots **A10** extending longitudinally along the outer sleeve **20**. The axial slots **A10** provide sufficient radial flexibility.

Regarding claim 3, the first connector **16** comprises a circumferential groove **16** and the second connector **13** comprises a flange **13** extending radially inwardly. The outer sleeve **20** is sufficiently resilient such that the outer sleeve **20** contracts.

Regarding claim 4, as modified above, the tapered external surface **12** of the outer sleeve **20** will have a minor diameter. The nut **30** has an external diameter **A22** greater than the minor diameter of the external surface **12** of the outer sleeve **20**.

Regarding claim 5, the external surface **12** of the outer sleeve **20** has a major diameter **A23** and the outer sleeve **20** comprises an external flange **13** extending radially outwardly adjacent the major diameter **A23** of the external surface **12** of the outer sleeve **20**.

Regarding claim 6, one end **A55** of the inner sleeve **10** is continuous about the circumference.

Regarding claim 7, the outer sleeve **20** is a one-piece sleeve comprising a slot **A18** (col. 4, lines 62-64) forming a section connected by a web **A28**. However, Muellenberg fails to disclose the slot **A10** being a plurality. Geib teaches, in Figure 1, a one-piece sleeve comprising a plurality of slots **27** to provide sufficient flexibility of an outer sleeve **21**. Therefore, as taught by Geib, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make more than one slot on the outer sleeve to provide sufficient flexibility of the outer sleeve.

Regarding claim 8, the outer sleeve **20** comprises a stop **A29**.

Regarding claim 19, the first connector **16** and the second connector **13** are operable to impede substantially axial displacement of the outer sleeve **20** relative to the nut **30** in a forward direction and a rearward direction.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muellenberg, 5,067,847 (see marked-up attachment provided in the last Office action), in view of Geib, 6,361,243, and further in view of Stegeman et al., 5,308,183.

Regarding claim 11, Muellenberg, as discussed above, fails to disclose the outer sleeve (vis. the external surface) comprising a frustoconical external surface having a minor diameter adjacent the forward end **A8** of the outer sleeve **20** and a major diameter spaced rearwardly from the minor diameter. Stegeman et al. disclose, in Figure 2, the external surface comprising a frustoconical external surface having a diameter spaced rearwardly from the minor diameter adjacent a forward end of an outer sleeve 22 and a major diameter spaced rearwardly from the minor diameter to engage a tapered bore in a machine element 14. Therefore, as taught by Stegeman et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the external surface **12** a tapered external surface to engage a tapered bore in the machine element.

Regarding claim 12, given the modification above, the nut **30** has an external diameter **A22** greater than the major diameter of the external surface **12**.

### ***Response to Arguments***

Applicant's arguments filed 07/28/2005 have been fully considered but they are not persuasive.

With respect to Muellenberg in view of Geib, applicant argues that the nut of Muellenberg does not meet the limitation "that rotating the nut in a first direction

operates to tighten the device, and rotating the nut in a second direction operates to loosen the nut, and that, in contrast, Muellenberg requires screws to be driven through the nut to loosen the device. In response, applicant should note that the nut inherently operates as argued. It is well established that rotating a nut in a first direction will tighten the device (the nut), and reversing the rotation will loosen the nut. The fact that the invention of Muellenberg requires screws to be driven through the nut does not affect the operation of the nut. Further, applicant should note that the species of Muellenberg relied to make the rejection is directed to Fig. 3, another species without screws. Furthermore, this limitation is given limited patentable weight. The limitation does not structurally define over Muellenberg and the limitation is a product-by-process limitation, which is given limited patentable weight.

Further, applicant argues that the flange 16 (the first connector) and the element 13 (the second connector) do not impede substantial axial displacement of the outer sleeve relative to the nut, but instead the outer sleeve can be readily displaced rearwardly relative to the nut. In response, the examiner disagrees as the flange 16 interferes with and slows (impedes) the axial displacement of the outer sleeve relative to the nut in one direction (forwardly). The fact that the flange 16 does not impede rearwardly does not mean it also impedes frontward. Applicant further argues that the pieces will lead to lost pieces. In response, this argument is irrelevant as the claims do not call for preventing pieces to be lost when the unit is not mounted onto a machine element. Further, it will be apparent that one skilled in the art will keep the parts

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together as long as loosening the parts does not totally disengage the parts. This will result the parts not being lost. Applicant further argues that there is no connection between the nut and the outer sleeve. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the nut is connected to the outer sleeve) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Muellenberg device operates complete opposite and therefore rotating the nut in a first direction does not displace the inner sleeve forward which displaces the major diameter of the external surface of the inner sleeve toward the minor diameter of the outer sleeve internal surface. In response, applicant should note that patentability is based on the structural limitations of the device of claim 1 and not on the method of operation. This argument will be more effective to prove that a claim to a method of operation is different. In any case, it is apparent that Muellenberg's device operates in different ways. For instance, rotating the nut counterclockwise advances the inner sleeve forward relatively to the nut (to the left of the device 200), which displaces the major diameter of the external surface of the inner sleeve toward the minor diameter of the outer sleeve internal surface.



Applicant further argues that the device Muellenberg operates such that the outer taper ring 20 is pulled to the left onto the inner taper ring by tightening the screw ring 30 and applicant makes reference to col. 3, lines 57-59. In response, it is noted that the reference to col. 4, lines 57-59 makes reference to the taper ring 20 being pulled to the left; however, this reference still does not obviate the reference from anticipating the claims. Muellenberg still operates as claimed such that rotating the nut in a first direction (counterclockwise) displaces the inner sleeve forwardly relative to the nut (the left side of the nut is the forward direction), which displaces the major diameter of the external surface of the inner sleeve toward the minor diameter of the outer sleeve internal surface.

With respect to Muellenberg, as applied to claim 9, applicant argues that there is no teaching in Muellenberg that inner sleeve is a one-piece sleeve. The examiner disagrees, as the inner sleeve 10 is a one-piece sleeve. From Fig. 3 or Fig. 1, one can see that the sleeve 10 has the radially projecting peripheral margin 7 and contains slots as depicted by the un-hatched cross-section of the sleeve in Figures 1 and 3. Applicant further argues that the outer sleeve does not have a circumferential interlock engaging the flange of the nut. Applicant should reconsider the argument as Muellenberg discloses a circumferential interlock 13 engages the flange 17 of the nut 30 since the bearing surface 16 of the flange 17 will eventually engage the circumferential interlock 13.

Applicant again argues in respect to claim 9 that the operation of the device operates in the exact opposite manner. In response, applicant should note that patentability is based on the structural limitations of the device of claim 1 and not on the method of operation. This argument will be more effective to prove that a claim to a method of operation is different. In any case, it is apparent that Muellenberg's device operates in different ways. In one instance, rotating the nut counterclockwise advances the inner sleeve forward relatively to the nut (to the left of the device 200), which in turn displaces the major diameter of the external surface of the inner sleeve toward the minor diameter of the internal surface of the outer sleeve.

Applicant argues, in respect to claim 15, that Muellenberg does not disclose the step of connecting the outer sleeve to the nut. In response, applicant should review Figure 11 as the drawing clearly shows the outer sleeve 20 connected to the nut and the inner sleeve connected to the nut. The fact that the flange of the outer sleeve is inside the nut is in itself connected to the nut. As a result of the connection, the nut impedes substantial axial displacement of the outer sleeve to the nut.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the limitations "connected" in claim 1, line 11, and "configured to engage" in claim 9, line 11, as amended on 7/28/2005, necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-70837083. The examiner can normally be reached from 9:30-6:00. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*E.G.*

E.G.

February 17, 2006

Attachment: one marked-up page of applicant's Figure 2 showing discrepancy.

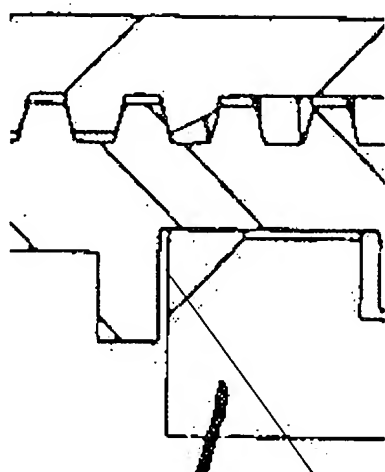
A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is fluid and cursive, with the first name "Daniel" being the most prominent part.

**DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**

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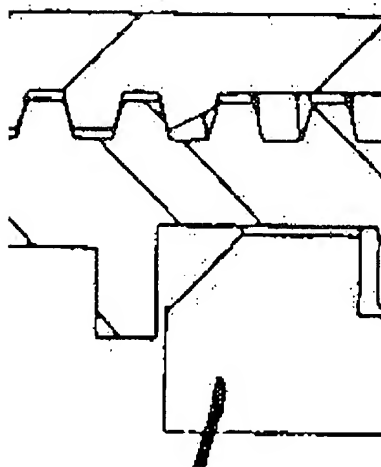
Applicant's Marked-up Figure 2

Incorrect



Line must be  
deleted on both  
top and bottom  
chamfers of  
Figure 2

Correct



Notice that the  
proper cross-  
section of the  
chamfer is correct